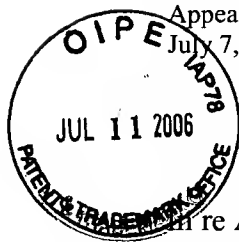


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Docket No. 10005.000120

Appeal Brief

July 7, 2006



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

in re Application of:

Jax B. Cowden et al.

Application No.: 09/993,906 Examiner: Divecha, Kamal B.

Filing Date: November 27, 2001 Art Unit: 2151

Assignee: Claria Corporation

Title: METHOD AND APPARATUS FOR DISTRIBUTING A COMPUTER PROGRAM

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF FILED UNDER 37 C.F.R. § 41.37

Sir:

This appeal brief follows the Notice of Appeal filed by Applicants on July 6, 2006.

A check covering the fee for filing an appeal brief is submitted herewith. If for any reason the check is insufficient or additional fees are required, the Commissioner is hereby authorized to charge the insufficiency to Deposit Account No. 50-2427.

I. REAL PARTY IN INTEREST

The real party in interest is Claria Corporation of Redwood City, California, which is the assignee of the present application.

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II. RELATED APPEALS AND INTERFERENCES

On information and belief, there are no appeals, interferences, or judicial proceedings known to the appellant, the appellant's legal representative, or assignee

which may be related to, directly affect or be directly affected by or have a bearing on the Board of Patent Appeals and Interferences decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1 and 3-9 are pending in this application and stand finally rejected.

Claims 1 and 3-9 are being appealed. These claims are rejected in the final office action mailed May 15, 2006 ("last office action").

IV. STATUS OF AMENDMENTS

No amendment has been filed after the last office action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter relates to distribution of computer programs over computer networks.

In independent claim 1, a partially disabled computer program is installed in a computer (Specification, page 29, line 20 to page 30 line 4; FIG. 10, action 1002). Among other advantages, this minimizes the impact of the computer program on the storage and computing resources of the computer until the computer program is subsequently accepted by the user (Specification, page 29, lines 21-22). The computer program is offered to the user after the computer program has been installed in the computer (Specification, page 30, lines 8-13; FIG. 10, action 1008). Claim 1 requires the computer program to be provided to the user after the user accepts the offer (Specification, page 31, lines 1-5; FIG. 10, action 1010), which as recited is after the installation of the computer program. The user is informed of the usefulness of the computer program when the user tries to uninstall the computer program (Specification, page 30, lines 18-20). Reminding the user of the efficacy of the computer program at a

time when the user is trying to uninstall it advantageously increases the chance of the user keeping the program (Specification, page 30, lines 20-23).

In independent claim 7, a partially disabled computer program is installed in a computer (Specification, page 29, line 20 to page 30 line 4; FIG. 10, action 1002). The efficacy of the computer program is then demonstrated to the user (Specification, page 30, lines 5-13; FIG. 10, actions 1004 and 1006). The computer program is offered to the user after the computer program has been installed in the computer (Specification, page 30, lines 8-13; FIG. 10, action 1008). The computer program is fully activated after the user accepts the offer (Specification, page 31, lines 1-5; FIG. 10, action 1010). The user is informed of the usefulness of the computer program when the user tries to uninstall the computer program (Specification, page 30, lines 18-20) after acceptance of the offer.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

To following grounds of rejection are to be reviewed on appeal:

- a) Rejection of claims 1, 4, and 7 under 35 U.S.C. § 103(a) as being unpatentable over InfoWorld in view of Quarterdeck.
- b) Rejection of claims 3, 6, 8, and 9 under 35 U.S.C. §103(a) as being unpatentable over InfoWorld in view of Quarterdeck and further in view of U.S. Patent No. 5,996,011).
- c) Rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over InfoWorld Publishing in view of Quarterdeck and further in view of Cinecom.

VII. ARGUMENTS

The aforementioned grounds of rejection are respectfully traversed.

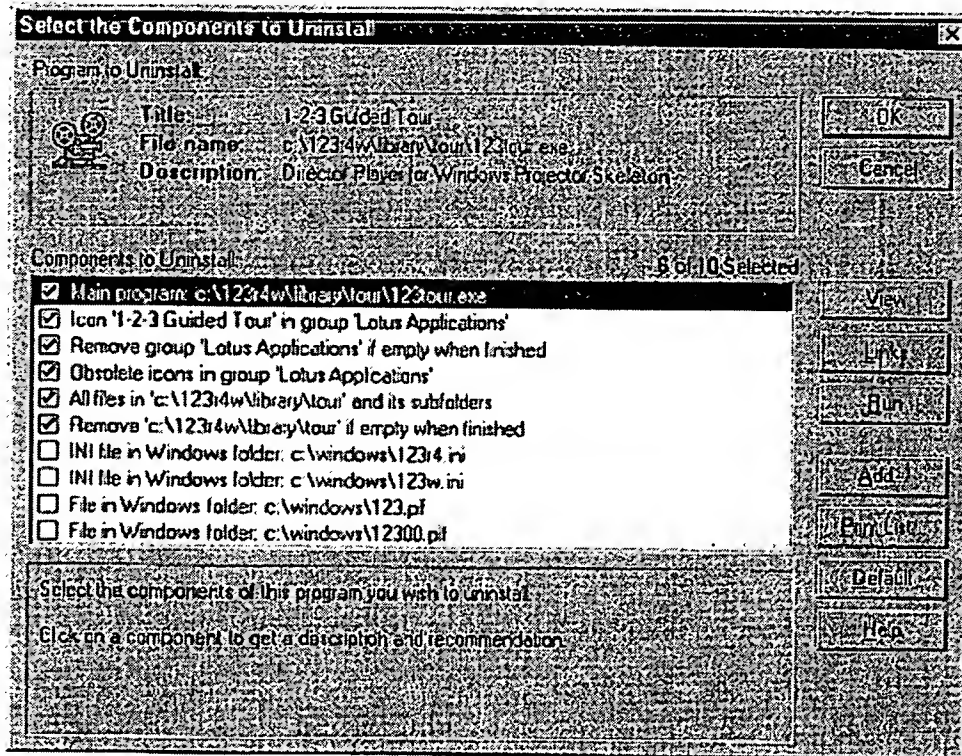
A. CLAIMS 1, 4, and 7

Claims 1, 4, and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over InfoWorld (InfoWorld Publishing, "Release Software and Demo 97 DemoLetter to

Provide Real Demos online,” pp. 1-2, February 1997) (“InfoWorld”) in view of Quarterdeck (“CleanSweep 95 Reviewer’s Guide,” dated 10/30/2001).

There are three requirements to establish a prima facie case of obviousness. First, there must be some suggestion or motivation to modify a reference or to combine references. Second, there must be a reasonable expectation of success. Third, the prior art reference or combined references must teach or suggest all the claim limitations. See MPEP § 2143.

Claim 7 is patentable over the combination of InfoWorld and Quarterdeck at least for reciting: “informing the user of usefulness of the computer program when the user tries to uninstall the computer program after accepting the offer.” As noted in the last office action, InfoWorld does not disclose this limitation. The last office action suggests that Quarterdeck discloses this limitation on page 9, noting that “selecting and clicking on a file or program provides the description and usefulness of program.” Applicants respectfully disagree with this conclusion.



The uninstall window shown in Quarterdeck page 9 is reproduced above. It is respectfully submitted that page 9 of Quarterdeck does not teach or suggest **reminding the user of the usefulness** of a computer program to be uninstalled. In fact, it is highly unlikely for Quarterdeck to be able to do so given that it does not even run the programs to be uninstalled. The most Quarterdeck can do is give a description of the program and how safe it is to remove the program from the computer. This is actually the case because all Quarterdeck does when the View button is clicked is to allow the user “to check the contents of the files that are candidates for deletion” (Quarterdeck page 9). The “description” provided by Quarterdeck is thus nothing more than telling the user what the program is for safety reasons, not to remind the user of the usefulness of the computer program (Quarterdeck, page 8).

Therefore, it is respectfully submitted that claim 7 is patentable over the combination of InfoWorld and Quarterdeck.

Claim 1 is rejected using the same rationale as that given for claim 7. Therefore, claim 1 is patentable over the combination of InfoWorld and Quarterdeck at least the same reasons given for claim 7. Claim 4 is patentable over the combination of InfoWorld and Quarterdeck at least for depending on claim 1.

B. CLAIMS 3 and 9

Claims 3 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over InfoWorld in view of Quarterdeck and further in view of U.S. Patent No. 5,996,011 to Humes (“Humes”).

Claim 3 is patentable over the combination of InfoWorld, Quarterdeck, and Humes at least for reciting: “wherein the act of informing the user of usefulness of the computer program includes informing the user a number of a type of **window** detected by the computer program” (emphasis added). As will be demonstrated below, the combination of InfoWorld, Quarterdeck, and Humes does not teach or suggest keeping track of the number and types of windows in a computer. Furthermore, there is no suggestion or motivation to combine Humes with InfoWorld and Quarterdeck to meet all the limitations of claim 3.

1. Humes does not disclose detection and tracking of types of windows.

As noted in the last office action, neither InfoWorld nor Quarterdeck teaches or suggests informing the user the number and type of windows detected by the computer program being uninstalled. The last office action suggests, however, that Humes discloses this limitation.

Humes detects contents received from web sites (i.e. web page) by URL. The last office action thus appears to be reading “website or web page as a type of window.” Applicants respectfully disagree with this conclusion. A window in the context of computers is a notoriously well understood term. Humes cannot and does not detect types of windows; Humes can only detect contents and source of contents (i.e., information) displayed in a window (a browser window), not the type of the window itself. The specification provides:

In the present disclosure, the term “window” is used to refer to any mechanism for presenting information to a user. Thus, the term “window” also includes message boxes, dialog boxes, text boxes, banners, etc. A window may be associated with a web browser, or may be generated as a result of receiving information from another computer over a computer network or from a local computer program. Specification, page 5, line 19 to page 6, line 1.

The above is consistent with the common usage of the term “window.” Note, however, that a mechanism for presenting information is not the information itself. Here, a web page of a website is merely information and cannot be used to present itself (i.e., the information). A web page needs to be included in a window to be presented to a user. Humes does not disclose detecting types of windows, let alone informing the user the number of a type of window detected.

Even in the improper construction that content is “a window” (it is not), Humes does not teach or suggest informing the user of **the number** of “types of websites or web pages” that have been filtered. While Humes uses a scoring system to determine whether to filter a web page, **the score itself is never presented to the user for any purpose.** Therefore, it is respectfully submitted that claim 3 is patentable over InfoWorld, Quarterdeck, and Humes. Claim 9 is patentable over InfoWorld, Quarterdeck, and Humes for similar reasons.

2. There is no suggestion or motivation to combine Humes with InfoWorld and Quarterdeck.

When read with claim 1, claim 3 requires that the user is informed of the number and type of windows detected by the computer program being uninstalled by the user. In the context of the rejection, this necessarily requires Quarterdeck to be modified with Humes such that Quarterdeck informs the user of the number and type of web pages detected by Humes' content-filtering program, which is being uninstalled. However, Quarterdeck cannot do this as it is a generic uninstaller (its key selling point) for the Windows Operating system. Quarterdeck does not run the program it is uninstalling or communicates with that program to learn of the number and type of detected web pages, if any. That is, there is no teaching in InfoWorld, Quarterdeck, or Humes to inform the user of the number and type of windows detected by a computer program, especially at a time when the user uninstalls that computer program. Such a teaching is only in the present disclosure – not in any of the references of record. Therefore, it is respectfully submitted that claim 3 is patentable over the combination of InfoWorld, Quarterdeck, and Humes. Claim 9 is patentable over InfoWorld, Quarterdeck, and Humes for similar reasons.

C. CLAIMS 6 and 8

Claims 6 and 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over InfoWorld in view of Quarterdeck and further in view of Humes.

Claim 6 is patentable over the combination of InfoWorld, Quarterdeck, and Humes at least for reciting: “wherein the computer program includes a window-blocking computer program.” As noted in the last office action, InfoWorld in view of Quarterdeck does not disclose a window-blocking computer program. The last office action suggests, however, that Humes discloses such a program. Applicants respectfully disagree with this conclusion.

Humes col. 2, line 31 to col. 3, line 22 and col. 4, lines 10-20, cited in the last office action, discuss filtering of web pages, **not the window** where the web page is displayed. That is, Humes discloses content (e.g., web page) filtering, not blocking of windows (e.g., browser, pop-up). As explained above, content is not the same as the

window where the content is displayed. For example, Humes cannot block proliferation of pop-up windows. Therefore, it is respectfully submitted that claim 6 is patentable over the combination of InfoWorld, Quarterdeck, and Humes. Claim 8 is patentable over InfoWorld, Quarterdeck, and Humes for similar reasons.

D. CLAIM 5

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over InfoWorld in view of Quarterdeck and further in view of Cinecom, document #1043564 (“Cinecom”).

Claim 5 is patentable over InfoWorld, Humes, and Cinecom at least for reciting: “wherein the act of providing the computer program to the user includes downloading **components** of the computer program from a remote computer” (emphasis added). Note that per claim 1, this downloading of components of the computer program occurs after the user accepts the offer, which occurs after installation of the computer program.

As noted in the last office action, InfoWorld and Quarterdeck do not disclose the process wherein the act of providing the computer program to a user includes downloading components of the computer program from a remote computer. Neither does Cinecom. Cinecom only discloses downloading **trial or full versions** of a computer program, not **components** of the computer program from a remote computer. More specifically, Cinecom does not teach or suggest downloading from a remote computer, components of a trial version or full version of a computer program after the trial version or the full version of the computer program has been accepted by the user, which offer must occur after the trial version or the full version of computer program has already been installed in the computer beforehand.

For at least the above reasons, claim 5 is patentable over InfoWorld, Quarterdeck, and Cinecom.

E. CLAIMS 1 and 3-9 (Prior Art Status of Quarterdeck)

Quarterdeck appears to discuss the features of CleanSweep 95 as it existed in October 30, 2001, which is the date of the document cited in the rejection. With a filing

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date of November 27, 2001, it is believed that Quarterdeck is not prior art to the present application. It is well established that references cited in an obviousness rejection under 35 U.S.C. § 103 must be prior art to the application. Accordingly, it is respectfully submitted that claims 1 and 3-9 are patentable.

VIII. CLAIMS INVOLVED IN THE APPEAL

The claims involved in the appeal are included in the Claims Appendix submitted herewith.

IX. CONCLUSION

For at least the above reasons, allowance of claims 1 and 3-9 is respectfully requested.

Respectfully submitted,
Jax B. Cowden et al.

Dated: 7/7/2006

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Typed or Printed Name:	Patrick D. Benedicto	Dated:	July 7, 2006
Express Mail Mailing Number (optional):			

CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL

1. A method to be performed in a computer, the method comprising:
installing a computer program in the computer, the computer program being partially disabled as installed;
offering the computer program to the user after installation of the computer program in the computer;
providing the computer program to the user after the user accepts the offer; and
informing the user of usefulness of the computer program when the user tries to uninstall the computer program after accepting the offer.
3. The method of claim 1 wherein the act of informing the user of usefulness of the computer program includes informing the user a number of a type of window detected by the computer program.
4. The method of claim 1 wherein the act of providing the computer program to the user includes activating the computer program.
5. The method of claim 1 wherein the act of providing the computer program to the user includes downloading components of the computer program from a remote computer.
6. The method of claim 1 wherein the computer program includes a window-blocking computer program.
7. A method to be performed in a computer, the method comprising:
installing a computer program in the computer, the computer program being partially disabled as installed;
demonstrating the efficacy of the computer program to a user;
offering the computer program to the user after installation of the computer program in the computer;
fully activating the computer program only after the user accepts the offer; and
informing the user of usefulness of the computer program when the user tries to uninstall the computer program after accepting the offer.
8. The method of claim 7 wherein the computer program includes a computer program for blocking a certain type of window.
9. The method of claim 7 wherein the act of demonstrating the efficacy of the computer program to the user includes informing the user of the number of windows of a certain type detected by the computer program.

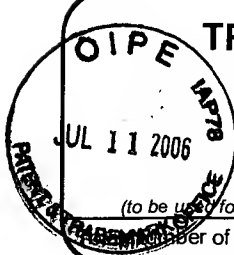
EVIDENCE APPENDIX

There are no documents or items submitted under this section.

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RELATED PROCEEDINGS APPENDIX

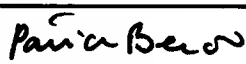
There are no documents or items submitted under this section.

 <p>TRANSMITTAL FORM</p> <p>(to be used for all correspondence after initial filing)</p>	Application Number	09/993,906	
	Filing Date	November 27, 2001	
	First Named Inventor	Jax B. Cowden	
	Art Unit	2151	
	Examiner Name	Divecha, Kamal B	
Number of Pages in This Submission	13	Attorney Docket Number	10005.000120

ENCLOSURES (check all that apply)


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Firm	Okamoto & Benedicto LLP		
Signature			
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